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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,757	10/06/2006	Kevin Michael Mills	139257WOUS	3807
81352	7590	09/03/2010	EXAMINER	
RG and Associates 1103 Twin Creeks Allen, TX 75013			KASRAIAN, ALLAHYAR	
			ART UNIT	PAPER NUMBER
			2617	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/599,757	Applicant(s) MILLS, KEVIN MICHAEL	
	Examiner ALLAHYAR KASRAIAN	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/08/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Information Disclosure Statement

2. The information disclosure statement submitted on 05/08/2009 has been considered by the Examiner and made of record in the application file.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 USC 101 since the claims are directed to non-statutory subject matter. **Claim 20** recites “**a computer readable medium**” which appears to cover both transitory and non-transitory embodiments. The United States Patent and Trademark Office (USPTO) is required to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. *See In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media **and** transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. *See* MPEP 2111.01. When the broadest reasonable

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interpretation of a claim covers a signal *per se*, the claim **must** be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 24, 2009; p. 2.

The Examiner suggests that the Applicant add the limitation "non-transitory computer readable medium" to the claim(s) in order to properly render the claims in statutory form in view of their broadest reasonable interpretation in light of the originally filed specification. The Examiner also suggests that the specification be amended to include the term "non-transitory computer readable medium" to avoid a potential objection to the specification for a lack of antecedent basis of the claimed terminology.

Claim Objections

4. **Claims 6, 16, 22, and 23** are objected to because of the following informalities:
- a) On **line 1** of **claim 6**, replace "4" with --5-- after "claim" (since "call process message" is defined in claim 5 not in claim 4);
 - b) On **line 1** of **claim 16**, replace "1" with --5-- after "claim" (since "the optional backward call" is defined in claim 5 not in claim 1);
 - c) On **line 1** of **claim 22**, insert --personal ring back tone-- before "module";
 - d) On **line 1** of **claim 23**, insert --personal ring back tone-- before "module";
- Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

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form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

A. **Claims 1-3, 7-15, 28, 30 and 31** are rejected under 35 U.S.C. 102(e) as being anticipated by **Beauford (US Patent Application Pub. # 20050094796)**.

Consider **claim 1**, Beauford discloses a method for providing a personalized ring back tone, comprising:

receiving a location request return result message at a mobile switching center (MSC) (FIG. 2, par. 0026);

based on the location request return result message, receiving an initial address message (IAM) at a personal ring back tone platform (par. 0029; IP 106 is considered as a personal ring back tone platform, see par. 0022, 0024 and 0034);

based on the IAM, receiving an address complete message (ACM) with an optional backward call indicator parameter at the MSC (par. 0032); and

providing the personalized ring back tone from the personal ring back tone platform while normal call progress is occurring (par. 0034).

Consider **claim 2 as applied to claim 1 above**, Beauford further discloses wherein the location request message is sent by a user's HLR (par. 0026).

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Consider **claim 3 as applied to 2 above**, Beauford further discloses wherein the personalized ring back tone is provided to a user's device (par. 0024).

Consider **claim 7 as applied to 2 above**, Beauford further discloses receiving an IAM from the MSC to a terminating network (par. 0029-0030).

Consider **claim 8 as applied to 7 above**, Beauford further discloses receiving an ACM from the terminating network to the MSC (par. 0032, 0037).

Consider **claim 9 as applied to 8 above**, Beauford further discloses receiving an answer message (ANM) from the terminating network to the MSC (par. 0033, 0037).

Consider **claim 10 as applied to 9 above**, Beauford further discloses receiving a release message from the MSC to the personal ring back tone platform (par. 0034, 0038).

Consider **claim 11 as applied to 10 above**, Beauford further discloses wherein the personalized ring back tone is no longer provided based on at least one of: the received release message or the ANM (par. 0034).

Consider **claim 12 as applied to 10 above**, Beauford further discloses wherein the calling party device is joined with a called party device (par. 0034).

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Consider **claim 13 as applied to 12 above**, Beauford further discloses wherein the called party device is associated with the ANM (par. 0033, 0037).

Consider **claim 14 as applied to 7 above**, Beauford further discloses wherein the terminating network includes the MSC (par. 0016, 0034).

Consider **claim 15 as applied to 7 above**, Beauford further discloses wherein the terminating network includes another MSC (par. 0016, 0034; it is inherently taught a mobile communication networks includes plurality of MSCs).

Consider **claim 28**, Beauford discloses a communications switch adapted to:
send a first call leg and a second call leg in parallel (par. 0034);
wherein the first call leg connects a calling party to a personalized ring back tone (par. 0034);
wherein the second call leg connects the calling party to a called party (par. 0034); and
wherein the first call leg is released upon a connection of the second call leg (par. 0034).

Consider **claim 30 as applied to claim 28 above**, Beauford further discloses wherein the release is based on a received answer message (par. 0034, 0038).

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Consider **claim 31 as applied to claim 28 above**, Beauford further discloses wherein the switch is at least one of a mobile switching center or an internet protocol based switch (par. 0030, 0033, 0034, 0016).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

A. **Claims 4, 21-27 and 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Beauford (US Patent Application Pub. # 20050094796)**.

Consider **claim 4 as applied to 3 above**, Beauford further discloses wherein the personalized ring back tone is provided between the personal ring back tone platform and the device (FIG. 2, par. 0034).

However, Beauford fails to explicitly disclose the personalized ring back tone is provided via an open reverse voice path.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use a voice channel or any particular channel or path to carry ring back tone or announcement to the calling party from IP 106 (the personal ring back tone platform). Applicant has not disclosed that providing a voice channel for carrying a ring back tone provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with Beauford's invention because the ring back tone or announcement is sent to the calling party with the same functionality and advantages of the Applicant's invention.

Therefore, it would have been obvious to one of ordinary skill in this art to modify the playing ring back tone of Beauford to obtain the invention as specified in claim 4.

Consider **claim 21**, Beauford discloses a system for providing a personalized ring back tone, comprising:

- a mobile switching center (MSC) (FIG. 1 and 2, par. 0016, , 0026); and
- a personal ring back tone module operably coupled to the MSC, the personal ring back tone module adapted to: accept at least one call leg of multiple call legs (par. 0034);
- and play the personalized ring tone via the voice channel (par. 0034).

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However, Beauford fails request a voice channel to be opened.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use a voice channel or any particular channel or path to carry ring back tone or announcement to the calling party from IP 106 (the personal ring back tone platform). Applicant has not disclosed that providing a voice channel for carrying a ring back tone provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with Beauford's invention because the ring back tone or announcement is sent to the calling party with the same functionality and advantages of the Applicant's invention.

Therefore, it would have been obvious to one of ordinary skill in this art to modify the playing ring back tone of Beauford to obtain the invention as specified in claim 21.

Consider **claim 22 as applied to claim 21 above**, Beauford further discloses wherein the module includes identifiers to a called party's sound files (par. 0019-0021, 0030).

Consider **claim 23 as applied to claim 22 above**, Beauford further discloses wherein the module receives an indication of the calling party form the MSC and based on the indication, provides a sound file identifier (par. 0029).

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Consider **claim 24 as applied to claim 23 above**, Beauford further discloses wherein the personalized ring tone is played to a calling party based on the received sound file identifier (par. 0019, 0034).

Consider **claim 25 as applied to claim 21 above**, Beauford further discloses wherein a second call leg of the multiple call legs is used to attempt a connection to a mobile number (par. 0034).

Consider **claim 26 as applied to claim 25 above**, Beauford further discloses wherein the personalized ring tone is played while the connection to the mobile number is attempted (par. 0021, 0034).

Consider **claim 27 as applied to claim 26 above**, Beauford further discloses wherein the personalized ring tone is stopped when the connection to the mobile number is successful (par. 0034 and 0038).

Consider **claim 32**, Beauford discloses a personal ring back tone module adapted to:

accept at least one call leg of multiple call legs (par. 0034);

and play the personalized ring tone via the voice channel (par. 0034, 0032).

However, Beauford fails to explicitly discloses request a voice channel to be opened.

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At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use a voice channel or any particular channel or path to carry ring back tone or announcement to the calling party from IP 106 (the personal ring back tone platform). Applicant has not disclosed that providing a voice channel for carrying a ring back tone provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with Beauford's invention because the ring back tone or announcement is sent to the calling party with the same functionality and advantages of the Applicant's invention.

Therefore, it would have been obvious to one of ordinary skill in this art to modify the playing ring back tone of Beauford to obtain the invention as specified in claim 32.

B. **Claims 5, 6, 16-20 and 29-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Beauford (US Patent Application Pub. # 20050094796)** in view of **DeMent et al. (US Patent Application Pub. # 20050117726)** (hereinafter DeMent).

Consider **claim 5 as applied to 1 above**, Beauford discloses the claimed invention except if the ACM is received without the optional backward call indicator parameter, receiving a call progress message with an optional backward call indicator parameter at the MSC.

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In the same field of endeavor, DeMent discloses if the ACM is received without the optional backward call indicator parameter, receiving a call progress message with an optional backward call indicator parameter at the MSC (par. 0132).

Therefore, it would have been obvious to a person or ordinary skill in the art at the time the invention was made to incorporate the optional backward call indicator as taught by DeMent to the ACM message as disclosed by Beauford for purpose of determining the called part status.

Consider **claim 6**, Beauford as modified by DeMent discloses the claimed invention **as applied to [4] 5 above**, and Beauford further discloses providing the personalized ring back tone from the personal ring back tone platform based on the received call progress message (par. 0033-0034).

Consider **claim 16 as applied to claim [1] 5 above**, DeMent discloses wherein the optional backward call indicator includes at least one of: an element header; an in-band information indicator=1; a call forward may occur indicator; a simple segmentation indicator; a network excessive delay indicator; a user-network interaction indicator=1; a MLPP user indicator; spare bits; or reserved bits (par. 0128, 0132, 0138).

Therefore, it would have been obvious to a person or ordinary skill in the art at the time the invention was made to incorporate the optional backward call indicator including in-band information and call forward indicators as taught by DeMent to the

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ACm message as disclosed by Beauford for purpose of causing value parameter indicating an unsuccessful call.

Consider **claim 17**, Beauford discloses a method for providing a ring back tone, comprising:

receiving an initial address message (IAM) at a sound platform from a mobile switching center (MSC) (FIG. 2, par. 0029; IP 106 is considered as a sound platform, see par. 0022, 0024 and 0034);

receiving an address complete message (ACM) at the MSC from the sound platform (par. 0032, 0037); and

providing the ring back tone from the sound platform (par. 0034).

However, Beauford fails to explicitly disclose the address complete message (ACM) includes an optional backward call indicator parameter.

In the same field of endeavor, DeMent discloses the address complete message (ACM) includes an optional backward call indicator parameter (par. 0132).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the optional backward call indicator as taught by DeMent to the ACM message as disclosed by Beauford for purpose of determining the called part status.

Consider **claim 18**, Beauford as modified by DeMent discloses the claimed invention **as applied to 17 above**, and Beauford further discloses wherein the ring back tone is received by a device associated with the IAM (par. 0022, 0034, 0002).

Consider **claim 19 as applied to 18 above**, and DeMent further discloses wherein the ring back tone is based on at least one of: a called party, a called party number, a called party device, a calling party, a calling party number, a calling party device, a time of day, a day of the year, or a location (par. 0003).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the custom ring-back tone service that may specify one of several audio clips to be played by a respective phone switch network based on caller identification, time-of-day, or other factors as taught by DeMent to ring back tone as disclosed by Beauford for purpose of specifying the type of ring back tone.

Consider **claim 20**, Beauford discloses a computer readable medium comprising instructions for:

receiving a first message at a first module from a second module (FIG. 2, par. 0029);

receiving a second message at the second module from the first module (par. 0032, 0037);

However, Beauford fails to explicitly disclose the second message includes an optional backward call indicator; and providing a ring back tone from the first module based on the received optional backward call indicator.

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In the same field of endeavor, DeMent discloses the second message includes an optional backward call indicator (par. 0132); and

providing a ring back tone from the first module based on the received optional backward call indicator (par. 0128, 0138).

Therefore, it would have been obvious to a person or ordinary skill in the art at the time the invention was made to incorporate the optional backward call indicator as taught by DeMent to the ACM message as disclosed by Beauford for purpose of determining the called part status.

Consider **claim 29 as applied to 28 above**, Beauford discloses the claimed invention except wherein the connection to the personalized ring back tone is based on a received optional backward call indicator parameter.

In the same field of endeavor, DeMent discloses wherein the connection to the personalized ring back tone is based on a received optional backward call indicator parameter (par. 0132).

Therefore, it would have been obvious to a person or ordinary skill in the art at the time the invention was made to incorporate the optional backward call indicator as taught by DeMent to the ACM message as disclosed by Beauford for purpose of determining the called part status.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

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- a. Chin et al. (U.S. Patent Application Publication # 20050221793) disclose Connect customized ring back tone service only at one MSC when intersystem page is involved.
 - b. Jiang et al. (U.S. Patent Application Publication # 20040120494) disclose Method and system for customized call termination.
 - c. Donnelly (U.S. Patent Application Publication # 20040223605) discloses System and method for customising call alerts.
 - d. Allison (U.S. Patent Application Publication # 20050113095) discloses Methods and systems for triggerless mobile group dialing
 - e. Kokkinen (U.S. Patent Application Publication # 20050105706) disclose Method and apparatus for providing pre-connection messaging and output.
8. Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to:**

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9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Allahyar Kasraian whose telephone number is (571)

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270-1772. The Examiner can normally be reached on Monday-Thursday from 8:00 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Pérez-Gutiérrez can be reached on (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

/Allahyar Kasraian/

Examiner, Art Unit 2617

/Rafael Pérez-Gutiérrez/

Supervisory Patent Examiner, Art Unit 2617